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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
8021-28

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on August 29, 2006Signature Typed or printed name Stanley A. Kim, Ph.D., Esq.

Application Number

10/734,050

Filed

December 11, 2003

First Named Inventor

GORDON, Andrew W.

Art Unit

1723

Examiner

Krishnan S. Menon

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/98)

- ☒ attorney or agent of record.
Registration number 42,730

- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Stanley A. Kim, Ph.D., Esq.

Typed or printed name

561-838-4512

Telephone number

Date

August 29, 2006

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 29 2006

In re: Application of GORDON, Andrew W.

Application No.: 10/734,050

Examiner: Krishnan S. Menon

Date filed: December 11, 2003

Art Unit: 1723

Confirmation No. : 9453

For: MOBILE DESALINATION PLANTS AND SYSTEMS, AND METHODS FOR
PRODUCING DESALINATED WATER

CERTIFICATE UNDER 37 CFR 1.8(A)

I hereby certify that this correspondence is being facsimile
transmitted to the Commissioner for Patents, Technology Center
1723, Central Fax Number 571-273-8300 on August 29, 2006.

_____, Reg. No. 42,730
Stanley A. Kim, Ph.D., Esq.

ARGUMENTS FOR PRE-APPEAL BRIEF CONFERENCE REQUEST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In support of the pre-appeal brief conference request, please consider the arguments
presented below:

Rejection of Claims 15 and 28-30¹ Under §§102/103 In View of Krylov (US 6,658,889)

This rejection is clearly erroneous because Krylov fails to teach or suggest claim 15's "a
concentrate discharge system ... comprising at least one discharge port," or claim 28's step of
"...discharging the diluted concentrate into the body of seawater...." Although Krylov is
completely silent on concentrate discharge, the examiner contends that the subject limitations are

¹ Note claim 29 was previously canceled and therefore not pending.

inherent. As previously argued, the examiner has not met the burden of proof required to show inherency because he has not provided any evidence whatsoever showing that concentrate discharge would necessarily flow from Krylov, or that such discharge would necessarily be into a body of seawater (claim 28) or via a discharge port (claim 15).² Applicant even suggested several alternative possibilities. The examiner's entire response was:

With respect to the Krylov reference, discharging the concentrate to the ocean would not constitute a patentable limitation over the reference. Discharging the concentrate is an inherent or implied teaching in the reference, as shown.

The two errors in this rejection are that (i) the substance of applicant's argument is not addressed as is required by MPEP §707.07(f) and (ii) no evidence whatsoever is presented that the alleged inherent characteristics necessarily flow from Krylov.

§103 Rejection of Claims 28, 31, and 32 In View of Bosley (US 6,348,148)

This rejection is clearly erroneous because Bosley fails to teach or suggest (i) diluting the concentrate with seawater prior³ to the step of discharging, (ii) discharging diluted concentrate into the body of seawater, or (iii) desalinating water "on a sea-going vessel." The examiner concluded that (i) and (ii) are obvious equivalents of Bosley's mixing concentrate with seawater *at the point* of discharge, but did not provide the required evidence that the alleged equivalency was recognized in the prior art.⁴ The examiner also did not respond to applicant's evidence⁵ and argument that active concentrate dilution before discharge is advantageous in protecting the marine environment and not equivalent to passive concentrate dilution after discharge.

The examiner also argued that Bosley's "...system suspended from a ship...would be 'on

² MPEP §2112 indicates " '[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.' *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)" and "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)."

³ I.e., if diluted concentrate is discharged, a step of diluting the concentrate must occur prior to discharge.

⁴ MPEP 2144.06 provides "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the *equivalency must be recognized in the prior art*, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958)"

⁵ See e.g., paragraphs [0039] and [0040] of the specification.

a ship” as recited in claim 28. In view of a previous rejection on a similar basis, applicant amended claim 28 to recite “on a sea-going vessel” rather than “*aboard* a sea-going vessel” and also expressly stated that the amendment was to clarify that the claims were not intended to encompass a method utilizing Bosley’s device secured to a location in a body of water by cables attached to ships. Despite the amendment and clarifying statement, the current office action erroneously argues that a “...system suspended from a ship...would be ‘on a ship.’”

§ 103 Rejection of Claims 15-23, 28-35, and 37-41 In View of Lampe and Bosley

The rejection of claims 15-23, 28, and 30-35 is clearly erroneous for the same several reasons presented in pages 13-17 of the last amendment. Regarding new claims 37-41, the examiner states that “[r]egarding the temperature and/or concentration being substantially equal to that of seawater at the point of discharge, Bosley recognizes this feature in the teaching that the concentrate is discharged at a location which has sufficient ocean currents to eliminate any adverse effect of such discharge.” Applicant does not follow this logic and disputes that Bosley teaches or suggests any pre-discharge temperature or salinity regulation.

In the last office action, in responding to applicant’s arguments, the examiner states:

...the “space for mixing” is not a patentable invention. It does not provide any particular structure to differentiate the claimed invention from the teaching of the reference. Applicant’s mixing of concentrate with seawater before discharge, the point of discharge and the relative dimensions, etc., would not constitute patentable inventions over the references because the references in combination already identifies the problem addressed by the invention and teaches a solution to the problem which is an obvious equivalent of the claimed limitation.

This response does not address the substance of applicant’s arguments. First, the examiner appears to summarily dismiss applicant’s argument that concentrate pre-discharge concentrate dilution is not equivalent to post-discharge concentrate dilution- even though he does not cite any prior art whatsoever that recognizes the alleged equivalency.⁶ Second, in contravention of MPEP §707.07(f), the examiner completely ignores applicant’s individual arguments regarding dependent claims 16, 17, 19, 20, 21, 22, and 23.

§ 103 Rejection of Claims 26, 27, and 37 in View of Lampe, Bosley, and Husick (US 5,830,366)

⁶ See Footnote 4.

This rejection is clearly erroneous because the examiner does not state any motivation to combine Husick's jet pump with the teachings of Lampe and Bosley. In the current office action, the examiner responds to applicant's prior argument with (i) a seemingly non-sensical statement that "[o]ne would use the teaching of Husick for continuously discharging the wastes as taught by Husick," (ii) an apparently irrelevant statement that applicant's argument is not commensurate with the scope of the rejection, and (iii) a statement that "...the motivation need not be the same as applicant; and the combination does not have to be a bodily incorporation...." Despite these assertions, the rejection remains erroneous because the examiner has still not provided any motivation or reason to combine the references as is required to make out a prima facie case of obviousness.⁷

Rejections Under 35 U.S.C. § 112, First Paragraph

A. In the written description rejection of claims 15-26 and 28-35 based on the use of "not at the first depth" is clearly erroneous. The examiner argues that the application does not provide adequate disclosure for the infinite possibilities for the locations which are "not at a first depth." According to MPEP 2163, "[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." The application teaches an intake and discharge at different depth levels for the purpose of reducing or eliminating the uptake of discharged concentrate into the water purification system (see paragraph [0131]). Original claims 1 (discharge deeper than intake) and 4 (intake deeper than discharge) describe both configurations. The discharge port and discharge is not anywhere in the universe; claim 15 indicates the discharge port is on the vessel and claim 28 indicates that the discharge is into a body of seawater. Taken together, the skilled artisan would have understood that applicant was in possession of the claimed invention at the time of filing.


B. The enablement rejection of claims 24 and 25 is clearly erroneous because instruments and sensors for determining the depth of a thermocline or plankton in a body of

⁷ Sec MPEP 2143. "To establish a prima facie case of obviousness... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

water were well known at the time the application was filed.⁸ In response to an earlier rejection on this basis, applicant provided the examiner a list of references describing examples of such instruments and sensors. In response the examiner stated that US 5,834,641 does not detect plankton and that applicant "...had neither incorporated (or quoted) this reference in the specification...nor provided this reference in an IDS with the filing of the application, which makes one wonder whether the applicant knew about this reference at the time of filing the application." First, the references cited clearly show that the subject instruments and sensors were well known prior to the filing date. Second, as applicant clearly stated, US 5,834,641 relates to thermoclines not plankton. Third, applicant is unaware of any statute or regulation that requires US 5,834,641 to be incorporated or quoted in the specification, to be disclosed in an IDS, or to have even been known to applicant at the time of filing.

Respectfully submitted,

Date: August 29, 2006


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Docket No. 8021-28

⁸ A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).